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AMOCO CORPORATION  
LAW DEPT MAIL CODE 1907A  
200 EAST RANDOLPH DRIVE  
PO BOX 87703  
CHICAGO IL 60680-0703

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EXAMINER

JUSKA, C

ART UNIT

PAPER NUMBER

1771

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application r proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/928,156

Applicant(s)

Bersted et al.

Examiner

Cheryl Juska

Group Art Unit

1771



☒ Responsive to communication(s) filed on May 26, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-59 and 80-91 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-59 and 80-91 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendment B, submitted as Paper No. 10 on May 26, 2000, has been entered. Claims 60-79 have been cancelled, while independent claims 1, 9, 31, and 41 have been amended. New claims 80-91 have been added. Thus, the pending claims are claims 1-59 and 80-91.
2. Amendment B is sufficient to withdraw the 112, 2nd rejections, as set forth in sections 6-8 of the last Office Action. Additionally, the claim objection and the 102/103 rejections, set forth in sections 9, 12, and 13 of the last Office Action, are hereby withdrawn due to the cancellation of claims 60-79. Furthermore, the prior art rejections based upon the cited Martin patent (US 3,152,380), as set forth in sections 14 -20 of the last Office Action, are hereby withdrawn due to Amendment B. In particular, Applicant's independent claims now recite a shrinkage of about 1-15%. The cited Martin patent teaches a shrinkage ranging from 21-54% (see Martin, Table V, col. 6). Also, the prior art rejection based upon the cited Lopatin patent (US 3,296,681), as set forth in sections 23 and 24 of the last Office Action, are hereby withdrawn due to Applicant's amendments and persuasive arguments.

### ***Double Patenting***

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention,"

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in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1-7, 16, 17, 22, 31, and 41-47, 80, 82, 83, 85, 86, 88, 89, and 91 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 11, 14-17, 24, and 25 of prior U.S. Patent No. 5,945,215 issued to Bersted et al. This is a double patenting rejection. Said rejection is maintained despite Applicant's amendments to independent claims 1, 9, 31, and 41. Said independent claims were amended to include limitations that the yarn "is textured" and has a shrinkage of about 1-15%. However, said amendments are not sufficient to overcome said rejection in that the new limitations are deemed to be inherent to the Bersted invention. Specifically, in a broad sense of the term, a bulked continuous filament as claimed by Bersted is inherently "textured." Additionally, the claimed shrinkage is an inherent result of Bersted's claimed polypropylene yarns.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 82, 85, 88, and 91 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Said claims limit the yarns to having an Apparent Average Microfibril Diameter greater than 200 [Å]. Applicant cites the specification, page 33, lines 3-10 as supporting the claimed value of greater than 200Å. However, said recitation clearly states that "known commercial carpet yarns...exhibit calculated values according to Formula (1) no greater than about 200Å." Said recitation does not clearly disclose the present invention of having said value of greater than 200Å. In fact, the specification continues at page 33, lines 8-14, to disclose that the present invention has values of at least 250Å, or preferably at least 275Å. Thus, Applicant has support for values of at least 250Å, but not for "greater than 200Å." Therefore, claims 82, 85, 88, and 91 are rejected as containing new matter.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 81, 84, 87, and 90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims limit the inventive yarns, wherein "the texture includes twist." Applicant states support for said limitation is found at page 37, lines 22-25 and page 54, line 26-page 55, line 6. The teachings of the noted specification state that one method of texturing the yarns are by a twist/detwist operation, or a false twist method (page 37, lines 22-25

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and page 54, lines 22-24). Additionally, the specification teaches the "textured yarns can be twisted" (page 54, line 26). Thus, it is unclear whether Applicant intends to limit the yarns to being textured by a false twist method or to limit the already textured yarns to twisting operation to impart a certain number of twists per inch.

9. Claims 82, 85, 88, and 91 are indefinite for the lack of units for the claimed Apparent Average Microfibril Diameter values. For the purposes of examination, said unit are taken as Angstroms (Å).

***Claim Rejections - 35 USC § 102/103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1-5, 16-25, 30, and 41-47 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the cited Wishman patent (EP 330 212), as set forth in section 21 of the last Office Action.

12. Claims 6-15, 26-29, 31-40, and 48-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Wishman patent, as set forth in section 22 of the last Office Action.

Applicant traverses said rejections by asserting that Wishman is directed to yarns with a particular form of crimp, while Applicant has amended the independent claims to recite the limitation that the yarn "is textured." Applicant also notes the specification, page 37, lines 22-20,

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which distinguishes "textured" yarns from "crimped" yarns. Said arguments are found unpersuasive, however.

First, although the specification makes a distinction between textured and crimped yarns, the broad definition of a "textured" yarn includes crimped yarns. (See *Introductory Textile Science*, pages 194 and 420 and *Fairchild's Dictionary of Textiles*, pages 151 and 573.)

Additionally, Wishman teaches the crimp yarns are "taken from the texturing region" (col. 3, lines 53-54). Secondly, it is asserted the limitation that the yarn "is textured" denotes a method limitation in a product claim. Although said method limitation may imply a structural difference, said structural difference between "crimping" and "texturing" (as defined in Applicant's specification) a yarn does not distinguish the presently claimed invention from the cited prior art. The final product of both inventions is a bulked yarn for carpets which is "crush-proof" or resilient. In other words, the objectives of the present invention are irrelevant to the method of bulking the yarn filaments. This is evidenced by Applicant's own disclosure which teaches crimped yarns are suitable for the invention (page 37, lines 22-27 and page 54, lines 22-25).

With regard to Applicant's argument that Wishman's cited compressional recovery test is "not a useful guide for predicting recovery relative to original properties" (Amendment B, page 13, lines 16-22), it is asserted that there is a correlation between Applicant's and Wishman's testing methods in that the resilient properties inherent to the yarns are being measured. Therefore, the prior art rejections based upon the cited Wishman patent are maintained.

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13. Claims 80, 82, 83, 85, 86, 88, 89, and 91 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the cited Wishman patent (EP 330 212).

Claims 80, 83, 86, and 89 limit the crystallinity of the yarn filaments to being at least 30%, while claims 82, 85, 88, and 91 limit the yarns to having an Apparent Average Microfibril Diameter (AAMD) greater than 200 [Å].

Although Wishman does not explicitly teach the claimed properties of crystallinity or AAMD, it is reasonable to presume that the inventive propylene fibers of Wishman inherently possess the claimed properties. Support for said presumption is found in Wishman's use of "essentially linear highly crystalline isotactic polypropylene which has a high molecular weight" (col. 2, lines 22-27). The burden is upon Applicant to prove otherwise. In the alternative, the claimed crystallinity and AAMD would obviously have been provided by the inventive yarn of Wishman. Note *In re Best* 195 USPQ 433.

14. Claims 81, 84, 87, and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Wishman patent.

One interpretation of the limitation of said claims is that the yarns have twist. Although Wishman does not explicitly teach twist in the inventive yarn, it would have been obvious to one of ordinary skill in the art to impart at least some twist. Applicant is hereby given Official Notice that it is a well-known convention in the textile arts to impart at least some amount of twist to continuous filament strand in order to form a cohesive yarn. Therefore, it would have been



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obvious to one skilled in the art to impart a twist to the Wishman filaments in order to produce a yarn. Thus, claims are rejected as being obvious over the cited prior art.

***Conclusion***


15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is (703) 305-4472. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached at (703) 308-2414. Fax numbers for this Group are (703) 305-3601 and (703) 305-7718.

cj

August 7, 2000

  
TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700